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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,591	01/24/2002	Todd S. Sones	074240.00002	4693

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HOLLAND & KNIGHT LLP
Suite 800
55 W. Monroe Street
Chicago, IL 60603

EXAMINER

SMITH, RICHARD A

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,591

Applicant(s)

SONES, TODD S.

Examiner

R. Alexander Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☒ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-6 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- I. Claims 1-4 drawn to a method of measuring.
- II. Claims 5 and 6 drawn to a device for measuring.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process of using can be done using a standard coilable tape measure or a yardstick.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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4. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none of claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephonic conversation between Mr. Steadman, Sr. on 05 May 2003 a **provisional election was made with traverse** to prosecute the invention of **Group I, i.e., claims 1-4**. Affirmation of this election must be made by applicant in replying to this Office action. **Claims 5 and 6** are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Information Disclosure Statement

6. The listing of references in the specification, i.e., U.S. patents 4,104,802, 3,208,150, 3,953,033, 4,655,457 and 5,469,627, is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The applicant should note that the examiner has cited these references on the PTO-892.

Specification

7. The specification is objected to because of the following informality: the abstract is objected to since it only discloses the method but not the apparatus.

Claim Objections

8. Claim 5 is objected to because of the following informality: "grips" in line 4 should be --grip--

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Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 1:

a. "the ball position spot" at the end of the claim makes the claim language indefinite because it is unclear what is meant by the ball position spot. The specification and drawings appear to address a ball or the ball's position; however, the use of "spot" makes the claim language confusing because "the ball position spot" does not appear to have an antecedent in the specification and the phrase as used does not clearly indicate which of the words is the noun, i.e., ball, position and/or spot. As written, the noun appears to be the spot, but what is meant by the word spot? Is it the ball itself a three-dimensional spot, is the spot the center of the ball, or is the spot the ground position on which the ball sits. If the spot is the ground position, then what size is the spot since this would affect the measurement taken.

b. The terminology "near" in the phrase "the near edge of the ball position spot" is a relative term which renders the claim indefinite. The term "near" is not defined by the claim, the

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specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example, using the ball as the object of near, is the edge to the top of the ball near, is the edge to the near side of the ball near, is the edge to the left or right side of the ball near? Each definition results in a different measurement based on what is considered to be near.

Claim 2: The formula of "calculating the length C where $C^2 = A^2 + B^2$ " makes the claim indefinite because the length C lacks an antecedent. To what limitation of claims 1 and 2 is the length C drawn?

Claim 3: Claim 1 discloses a position and stance of a golfer and taking of a measurement distance to a ball position spot to determine the proper length of a putter club. Claim 3 is indefinite since there is no antecedent for a club head? Is this the club head of the putter club disclosed in claim 1 or is this a club head of an apparatus as shown in figure 3 but not claimed? Furthermore, the phrase "pivoting the club head about an axis parallel to the intended direction of ball movement" is indefinite because it is unclear where and in what context the pivoting occurs. Is this the golfer pivoting through the stroke wherein his pivoting axis (basically through the shoulders) is parallel to the intended direction of ball movement? Or again, is this describing the pivot point at 19 for the apparatus as shown in figure 3 which is not claimed?

Since the examiner cannot determine the metes and bounds of this claim, no prior art is being applied.

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Claim 4: "after the length has been selected" makes the claim indefinite because there is no preceding limitation that discloses that a length has been selected. Claim 1 addresses limitations for taking a measurement to determine the proper length of a putter club, but does not disclose that this said (measured) length has been selected or that a putter club having said (measured) length has been selected.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Arm Your Stroke, Sink More Putts" by Todd Sones [hereinafter Sones] in view of How To Buy A Putter, Golf Buyers Guide, DicksSportingGood.com [hereinafter Dicks].

Sones discloses a method (last paragraph of the section titled the set-up) of individually fitting a golf putter for an individual golfer which comprises positioning the golfer on level ground, determining the proper length of a golf putter club by balancing the golfer's weight over

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the ball of the foot, simultaneously tilting his torso forwardly about his hips to position his eyes directly above a ball position spot, and simultaneously positioning his hands directly below his shoulders and forward of his legs and torso.

Sones does not disclose positioning the golfer with his hip sockets directly above his heels, measuring the distance from the heel of his palm to the near edge of the ball position spot, and the method of claim 2.

With respect to positioning the golfer with his hip sockets directly above his heels: The balance of the golfer's weight over the balls of his feet and the compact positioning of the golfer as shown in the bottom right-hand figure on page 81 of Sones appears to meet this limitation. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to position the hip sockets directly above the heels, as suggested by Sones, in order to obtain a compact putting stance while keeping the balance of the golfer over the balls of his feet.

Dicks teaches that the distance to measure with respect to the golfer is just above the top of his hands. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method, taught by Sones, by adding a measurement to just above the top of the hands, as suggested by Dicks, in order to properly size a putter. With respect to measuring the distance from the heel of his palm as claimed by Applicant: The position of the heel of the palm based on figure 1 as shown by applicant appears to the examiner as being equivalent to the location taught by Dicks.

With respect to measuring to the near edge of the ball position spot: Sones in the bottom right-hand figure on page 81 shows the putter with the shaft directly in line with the near edge of

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the ball when the golfer is in the proper putter position setup and teaches in the column titled "The Stroke" that this position places the putter head at the lowest point of the arc during the stroke. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to measure to the near edge of the ball position spot, as suggested by Sones, in order to obtain a putter which when swung would remain low to the ground without digging into the ground.

With respect to the method of claim 2, i.e., taking the measurements of the sides and using the Pythagorean Theorem to calculate the hypotenuse: this is a very well known formula for calculating a distance when said distance meets the requirements of said theorem. Therefore, the direct measurement method, taught by Sones as modified by Dicks, and that of claim 2 using the Pythagorean Theorem is considered to be equivalent to the direct measurement, since 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained if one is used instead of the other, as long as the measured distance represents the proper length of a golf putter club, as already taught by Sones and Dicks, and 2) the measurement method claimed by Applicant and direct measurement method used by Sones as modified by Dicks are well known alternate types of measurement methods which will perform the same function, if one is replaced with the other, of measuring the proper length of a golf putter club.

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13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sones and Dicks as applied to claims 1 and 2 above, and further in view of U.S. 6,379,264 to Forzano.

Sones and Dicks together teach all that is claimed as discussed in the above rejections of claims 1 and 2 except for the limitations of claim 4.

Forzano discloses adjusting the weight of the putter head and grip to provide a selected swing weight in order to suit a golfer's putter stroke and to change the location of the sweet spot (column 3, lines 41-49). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the head and grip, taught by Sones and Dicks, by altering the weight, as taught by Forzano, in order to provide the selected swing weight based its suitability to the golfer's putting stroke and to change the sweet spot.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related methods.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Smith whose telephone number is (703) 305-0647. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

RAS
May 5, 2003X